

Appl. No. 10/782,322
Atty. Docket No. 9164M
Amdt. dated 10/28/2005
Reply to Office Action of 07/28/2005
Customer No. 27752

REMARKS

Claims 47, 50-54 and 56-59 are now in the case.

Applicants have amended claim 47 to include the feature of a penetration value being measured according to ASTM standard test D1321.

Each of the amendments is supported by the specification, claims and drawings as filed (see *inter alia* page 9, lines 29-34 of the specification)

Rejection under 35 U.S.C. § 112

Claims 47, 50-54 and 56-59 have been rejected under 35 U.S.C. 112, first paragraph for reasons of record at paragraph 2 of the office action dated July 28, 2005.

As suggested by the Examiner, Applicants have amended claim 47 to include the features of a penetration value being measured according to ASTM standard test D1321.

It is therefore Applicants' position that the amendment overcomes the rejection under 35 U.S.C. 112.

Reconsideration and withdrawal of the rejections are therefore requested.

Rejection under 35 U.S.C. § 103

Claims 47, 50, 52-54 and 56-59 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown et al. '064 in view of Childs et al. '834.

Applicants appreciate and acknowledge the mention by the Examiner that the previous "rejection of the claims as being unpatentable over Childs in view of the secondary references is withdrawn in view of Applicants' submission of the 1.132 Declaration."

The office action alleges that "[i]n reference to claims 47, 56-57 and the penetration value, one would have reasonably expected the additives of the cleaning sheet

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of Brown to have the claimed penetration value since Brown teaches using the cleaning sheets of Quickle® and Grab-it® which are similar to applicant's cleaning sheet of Quickle® and Pledge Grab-it®, as recited on page 26 of the instant specification."

The office action also alleges that "since the Quickle and Grab-it sheets of Brown et al. may contain the microcrystalline wax, the examiner sees no difference between the cleaning sheet of Brown and examples 16 and 18 on page 26 of the instant specification."

Applicants respectfully disagree.

Applicants note that although Brown et al. generally disclose at Col 19, line 1-12, that among many different waxes from mineral source, a microcrystalline wax can be used as an additive, Brown et al is totally silent about the penetration value of such an additive.

In the previous communication submitted by Applicants, Applicants have already demonstrated in the declaration of Nicola John Policicchio, Principal Scientist at The Procter & Gamble Company, that not all microcrystalline waxes produces an additive having the presently claimed penetration value.

Consequently, it is Applicants' position that the office action has failed to establish a *prima facie* case of obviousness and is relying on hindsight reconstruction of the claimed invention.

In addition, the office action asserts that "[t]he 1.132 Declaration is persuasive in part. The Examiner agrees that the microcrystalline wax (SP No. 617) on page 17 of Childs does not have a penetration value as recited in Claim 47 based on the 1.132 Declaration. However, the 1.132 Declaration does not provide evidence that all microcrystalline waxes of Childs do not have the recited penetration values. The Declaration is only only persuasive for the particular example on page 17 of Childs." (Emphasis added)

Applicants note that the office action should "[c]onsider the size of the prior art genus, bearing in mind that size alone cannot support an obviousness rejection." See MPEP 2144.08 4. II. A. 4. (a) citing *In re Baird*, 16 F.3d at 383 and that "[s]ome

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motivation to select the claimed species or subgenus must be taught by the prior art,"
Deuel, 51 F.3d at 1558-59.

Applicants also remind the Examiner that "[t]he fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious." See MPEP 2144.08 II.

Applicants have previously demonstrated in the declaration of Nicola John Policicchio, Principal Scientist at The Procter & Gamble Company, that not all microcrystalline waxes produces an additive having the presently claimed penetration value.

It is Applicants' position that the office action is putting an unreasonable burden on Applicants by requesting that Applicants demonstrate that all the microcrystalline waxes of Childs or even Brown et al. do not have the claimed penetration value.

Consequently, it is Applicants' position that the office action has failed to establish a *prima facie* case of obviousness by relying on hindsight reconstruction of the claimed invention.

Reconsideration and withdrawal of the rejections are therefore respectfully requested.

It is submitted that all the claims are in condition for allowance. Early and favorable action on all claims is therefore requested.

If the next action is other than to allow the claims, the favor of a telephonic interview is requested with the undersigned representative.

Respectfully submitted,

For POLICICCHIO ET AL.

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